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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,741	10/03/2003	Hassan Mostafavi	2018721-7012094003	6107

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VARIAN MEDICAL SYSTEMS TECHNOLOGIES, INC.
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EXAMINER

RAMIREZ, JOHN FERNANDO

ART UNIT	PAPER NUMBER
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3737

MAIL DATE	DELIVERY MODE
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09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/678,741

Examiner

John F. Ramirez

Applicant(s)

MOSTAFAVI, HASSAN

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on July 2, 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.
- ☒ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):
see attachment

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

DETAILED ACTION

Response to Arguments

The response filed 7/2/2007 is non-compliant because while the applicant listed 19 related applications/patents, the applicant objected to and did not identify specific claims of those applications or patents which may present double patenting issues with the instant application claims. The applicant objected on the grounds that such a request is beyond the scope of rule §1.105, further arguing that rule 105 should only be used to seek factual evidence and may not be used to formulate an opinion.

With regard to seek an "opinion", first the examiner does not believe the requested information would in fact be considered an "opinion" as argued by the applicant, because deciding if the claims should be specified is based on the factual differences between the claims. However, if it is considered an "opinion" the examiner believes that while the use of rule 1.105 for "opinion" will not be encouraged it is not precluded.

It is the examiner position that the request under 1.105 only requested an identification of specific claims that "may" present double patenting issues and invited the applicant to take appropriate action in the interest of expediting the prosecution of the current application. If the applicant had pointed out specific claims the examiner would have made a determination of patentability regarding those claims. Further, the examiner believes that the instant application currently includes 62 elected claims while the applicant listed applications and patents include a very large amount of claims. The applicant elected to file a large number of claims and therefore is required to share the

burden of indicating the specific claims among all the claims, which may present double patenting issues.

This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting. Because the applicant is both far more aware of the contents of the claims in these applications than any Office staff, and has access to the source documents by which such comparison could be done better than within the Office, it is reasonable to require the applicant to provide the information needed to determine the commonality among the claims. If the applicant becomes aware of any additional applications or patents that should be included in the listing the applicant should update the supplied list.

The request for information is therefore considered proper and repeated below.

37 CFR 1.105 REQUIREMENT FOR INFORMATION

Applicant (or the assignee of this application if the assignee has undertaken the prosecution of the application) is required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

There are numerous other co-pending applications and issued patents, which disclose and claims very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11 (a) subsection G, applicant (or the assignee) is

respectfully requested to disclose all co-pending applications and related patents (please see the non-exhaustive list below of applications and issued patents that the USPTO believes may be related) and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. This requirement is reasonably necessary to examination because, based on an initial review of the applications, there is a significant degree of overlap in claimed subject matter, thus requiring an analysis of commonality of claimed subject matter to determine patentability under 35 USC 101 double patenting and/or obviousness type double patenting. Because the applicant (or the assignee) is presumably far more cognizant of the contents of the claims in these applications than any Office staff, and has access to the source documents by which such comparison could be done better than within the Office, it is reasonable to require the applicant to provide the information needed to determine the commonality among the claims.

Should applicant (or the assignee) believe that Double Patenting exists, then applicant (or the assignee) is invited to file Terminal Disclaimers and/or amend the currently pending claims in the interest of expediting the prosecution of the current application. Applicant (or the assignee) should note that a terminal disclaimer is effective to overcome an obviousness type double patenting rejection, but will not overcome a "same type" double patenting rejection under 35 U.S.C. § 101.

Non-exhaustive list of possible related co-pending applications and patents:
U.S. Serial No. 09/178,385 filed October 23, 1998 now U.S. Patent No. 6,279,579;
U.S. Serial No. 09/178,383 filed October 23, 1998 now U.S. Patent No. 6,621,889;

U.S. Serial No. 09/178,384 filed October 23, 1998 abandoned;
U.S. Serial No. 09/712,724 filed November 14, 2000 now U.S. Patent No. 6,690,965;
U.S. Serial No. 09/893,122 filed June 26, 2001 now U.S. Patent No. 6,937,696;
U.S. Serial No. 09/940,679 filed August 27, 2001;
U.S. Serial No. 10/234,658 filed September 3, 2002 now U.S. Patent No. 6,973,202;
U.S. Serial No. 10/305,416 filed November 25, 2002 now U.S. Patent No. 6,980,679;
U.S. Serial No. 10/327,603 filed December 20, 2002;
U.S. Serial No. 10/664,534 filed September 16, 2003 now U.S. Patent No. 6,959,266;
U.S. Serial No. 10/957,009 filed September 30, 2004;
U.S. Serial No. 11/105,884 filed April 13, 2005;
U.S. Serial No. 11/116,699 filed April 27, 2005; and
U.S. Serial No. 11/218,960 filed September 1, 2005.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

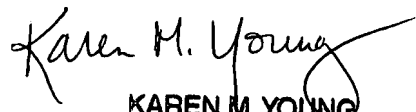
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John F. Ramirez whose telephone number is (571) 272-8685. The examiner can normally be reached on (Mon-Fri) 7:30 - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JFR


ELENI MANTIS MERCADER
SUPERVISORY PATENT EXAMINER


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